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EXAMINER

GART, MATTHEW S

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/725,713

**Applicant(s)**

NII, NAOAKI

**Examiner**

Matthew s Gart

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 29-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/20/2004 has been entered.

Claims 1-48 are pending in the instant application. Claims 29-48 were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 1-28 stand rejected under 35 U.S.C. 103 as being unpatentable over United States Patent 6,457,640 in view of United States Patent 5,973,773.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-28 are rejected under 35 U.S.C. 112 first paragraph**

Referring to claims 1-28. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification as originally filed (11/30/2000) did not disclose a content provider wherein the content is not provided from integrated circuit cards. The specification as originally filed did disclose that the content provider might be a database at a kiosk, might be remote from the kiosk, or might be a personal computer, a notebook computer, a wireless personal terminal, or any other processor system having sufficient memory. A smart card can be construed as a processor having sufficient memory. An accepted industry-wide definition of a "smart card" is a credit card size device/component containing an embedded microprocessor chip that stores information for retrieval, which information has previously been written therein.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran U.S. Patent No. 6,457,640 in view of Findley U.S. Patent No. 5,979,773.**

Referring to claim 1. Ramachandran discloses a multimedia content delivery system, comprising

- A content provider having a plurality of multimedia files therein (Ramachandran: column 4, lines 16-29);
- An input device for selecting a multimedia file from the plurality of multimedia files (Ramachandran: column 4, lines 37-59);
- An output device for selecting a multimedia file from the plurality of multimedia files (Ramachandran: column 4, lines 37-59); and
- A control unit (Ramachandran: "computer processor 12"), for actuating said output device to provide the content of a multimedia file from the content provider selected by said input device under control of authorization information; and wherein the content is not provided from an integrated circuit card (Ramachandran: Figure 1).

Ramachandran does not expressly disclose a system comprising:

- A second integrated circuit card interface for receipt of a user integrated circuit card containing second authorization information; and
- A control unit, responsive to insertion into said second integrated circuit card interface of a user interface card containing second authorization information compatible with the first authorization information contained in a host integrated circuit card inserted in said first integrated circuit card interface.

Findley discloses a system comprising:

- A second integrated circuit card interface for receipt of a user integrated circuit card containing second authorization information (Findley: Fig. 1, "A"); and
- A control unit (Findley: Fig. 1, "10"), responsive to insertion into said second integrated circuit card interface of a user interface card containing second authorization information compatible with the first authorization information contained in a host integrated circuit card inserted in said first integrated circuit card interface (Findley: column 1, line 46 o column 2, line 25).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Ramachandran to have included the system of Findley in order to provide an electronic data access and retrieval system for accessing and retrieving digital data information securely (Finley: column 5, lines 9-15).

Referring to claim 2. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a multimedia terminal having said content provider, said first integrated circuit card interface said control unit therein enclosed therein (Ramachandran: Fig. 2).

Referring to claims 3-4. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises an audio and video output device (Ramachandran: column 7, lines 49-59).

Referring to claim 5. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said output device comprises a communication link permitting downloading of the selected multimedia file in electronic form (Ramachandran: column 7, lines 49-59).

Referring to claim 6. Ramachandran in view of Finley discloses a system according to claim 5 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said communication link is a wireless communication link (Ramachandran: column 4, lines 37-49).

Referring to claims 7-8. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said input device, said output device, and said control unit comprise a laptop computer and a wireless personal terminal (Ramachandran: column 4, lines 37-49).

Referring to claim 9. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider comprises a server (Ramachandran: Fig. 1).

Referring to claim 10. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said content provider further comprises a mainframe computer coupled to said server (Ramachandran: Fig. 1)

Referring to claim 11. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a server connected to said content provider (Ramachandran: Fig. 1).

Referring to claim 12. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system comprising a mainframe computer connected to said server (Ramachandran: Fig. 1).

Referring to claims 13-14. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said multimedia files comprise audio and video media (Ramachandran: abstract).



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Referring to claims 15-18. Ramachandran in view of Finley discloses a system according to claim 1 as indicated supra. Ramachandran further discloses a multimedia content delivery system wherein said video media comprises text, books, newspapers and games (Ramachandran: column 6, lines 53-62).

Referring to claim 19. Claim 19 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claim 1 and 2.

Referring to claim 21. Claim 21 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claim 4.

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth above in claim 5.

Referring to claim 24. Claim 24 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 25. Claim 25 is rejected under the same rationale as set forth above in claim 1 and 2.

Referring to claim 26. Claim 26 is rejected under the same rationale as set forth above in claim 3.

Referring to claim 27. Claim 27 is rejected under the same rationale as set forth above in claim 4.

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Referring to claim 28. Claim 28 is rejected under the same rationale as set forth above in claim 5.

### ***Response to Arguments***

Applicant's arguments filed 8/20/2004 have been fully considered but are moot in view of the new grounds for rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The new ground of rejection includes a new rejection under 35 U.S.C. 112, and a revised rejection under 35 U.S.C. 103 (the combination of Ramachandran in view of Findley was modified).

The Examiner notes, the Applicant's arguments concerning the content provider being the first integrated circuit card is moot. In the new combination of the Ramachandran reference and the Findley reference, the content provider as disclosed by Ramachandran can be at least one remote digital information source (Ramachandran: column 7, line 43 to column 8, line 8).

### ***Conclusion***

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding

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is assigned are 703-746-7239 for regular communications and 703-746-7238 for

After Final communications.

Any inquiry of a general nature or relating to the status of this application  
or proceeding should be directed to the receptionist whose telephone number is  
703-305-3900.

A handwritten signature in black ink, appearing to be 'ML' followed by a horizontal line.

MSG  
Patent Examiner  
October 4, 2004